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SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS MO 63102

In re Application of
POPP ET AL.
Serial No.: 10/036,573
Filed: December 31, 2001
Docket: KCC 4770 (K.C. NO. 17,310)
Title: MECHANICAL FASTENING SYSTEM
FOR AN ABSORBENT ARTICLE

DECISION ON PETITION
TO WITHDRAW REJECTION
UNDER 37 CFR 1.181

This is a decision on the petition filed on February 20, 2006 by which petitioners request withdrawal of the final Office Action dated December 21, 2005.

The petition is **GRANTED-IN-PART**.

A review of the relevant prosecution history shows that on June 22, 2005 the applicant filed an amendment to the claims, drawings and specification after a non-final rejection. The examiner subsequently issued a final Office Action on December 21, 2005. The examiner made numerous objections and rejections including, *inter alia*, objections to the drawings under 37 CFR 1.83(a) and as incomplete, objections to the specification as containing new matter as well as being unclear and inconsistent, and rejections to the claims as containing new matter.

Applicant's Request for Relief

The applicant filed the present petition on February 20, 2006. The applicant requests seven points of relief, namely:

- A. Entry of amended Figure 2;
- B. Entry of amended Figure 3;
- C. Entry of Figures 8, 9a, and 9b;
- D. Withdrawal of the examiner's objection to the drawings under 37 CFR 1.83(a);
- E. Entry of the amendment to paragraph beginning "Figure 9 is" at page 5 of the specification;
- F. Withdrawal of the examiner's objection to the disclosure based on "oriented nonwoven loop material" being unclear and inconsistent; and

G. Withdrawal of the examiner's objection to the Amendment filed June 22, 2005 under 35 USC 132(a) as introducing new matter.

Applicable Statutes and Rules

MPEP 2163.06(I), Treatment of New Matter, states in relevant part: "If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. 132 or 251 as appropriate, and require applicant to cancel the new matter. If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement."

MPEP 2163.06(II), Review of New Matter Objections and/or Rejections, states:
"A rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR 1.181. *If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.*" (Emphasis added).

Issues Presented

There are two issues in the present petition. The first is whether the examiner properly denied entry of the amended Figures 2 and 3. The second is whether the objections and rejections containing the term "oriented nonwoven loop material" contain new matter directly or indirectly and are properly petitionable or appealable.

Analysis

I. Entry of Amended Figures 2 and 3 (Points of Relief A and B as Above)

The petitioner argues that amended Figure 2 should be entered. The petitioner argues that the only difference between the original Figure 2 and amended Figure 2 is "to simply add a lead line from reference number 66 to the structure it denotes . . ." Moreover, the petitioner is unsure of the rationale for disallowing the amended Figure 2 since the examiner has offered no explanation.

The petitioner also argues that amended Figure 3 should be entered. The petitioner argues that the only difference between the original Figure 3 and amended Figure 3 is "to simply delete reference 78 and the associated lead line." Moreover, the petitioner is unsure of the rationale for disallowing the amended Figure 3 since the examiner has offered no explanation.

The petitioner's argument is persuasive. The amendment of Figure 2 to include the lead line was done at the request of the examiner in the non-final Office Action of September 15, 2003. The amendment of Figure 3 to delete reference 78 was also done at the request of the examiner in the September 15, 2003 Office Action. Accordingly, Points of Relief A and B, namely the entry of amended Figures 2 and 3, are GRANTED.

II. Petitionability or Appealability of New Matter (Points of Relief C, D, E, F and G as Above)

In the December 21, 2005 Office Action, the examiner objected to the June 22, 2005 amendment to the specification under 35 U.S.C. 132(a) on the grounds that it introduced new matter into the disclosure. Specifically, the examiner found that “Applicant now sets forth a new definition of the term “oriented nonwoven loop material”. See December 21, 2005 Office Action, Page 6, Paragraph 7.

The examiner rejected Claims 3, 9, 28, 30-31, 33-37 and 40-43 under 35 U.S.C. 112, first paragraph. Specifically, the examiner rejected the terminology “oriented nonwoven loop material” as not sufficiently described in the specification. See December 21, 2005 Office Action, Page 8, Paragraph 9.

The examiner objected to the description since the term “oriented nonwoven loop material” is unclear and inconsistent. The examiner found the definitions supplied within the specification itself inconsistent, and these definitions are also inconsistent with the definition supplied within the claims. See December 21, 2005 Office Action, Page 4, Paragraph 6.

The examiner objected to the June 22, 2005 amendment to the specification based on the incorrect form of the correction under 37 CFR 1.121. The amendment contained the description “Figure 9a is a top plan view of an *orientable non-woven loop material* Figure 9b is a top plan view of the loop fastener of Fig. 8 with the *loop material* of Fig. 9a shown drawn to *orient* constituent fibers of the *loop material* . . .” (*Emphasis added*). See December 21, 2005 Office Action, Page 2, Paragraph 2.

The examiner objected to figures 8, 9a, and 9b because, *inter alia*, “Nor is it clear that such shows an ‘oriented nonwoven loop material’ as now defined at page 9 . . .” See December 21, 2005 Office Action, Page 2, Paragraph 3.

The examiner also objected to the drawings under 37 CFR 1.83(a) as not showing the “oriented nonwoven loop material.” In particular, the examiner has requested the applicant to show “such loop material in which the fibers are or are being, not were or have been, oriented by the application of force, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.” See December 21, 2005 Office Action, Page 3, Paragraph 5.

MPEP 2163.06(II) states in relevant part: “If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.”

The petitioner has offered various reasons to overcome the objections mentioned above. However, in light of MPEP 2163.06(II), these objections are appealable rather than petitionable.

MPEP 2163.06(II) has two requirements that make an issue appealable rather than petitionable. First, the claims and the specification must both contain new matter either directly or indirectly. Second, there must be both a rejection and an objection by the examiner.

For the first requirement, the examiner objected to the June 22, 2005 amendment under 35 U.S.C. 132(a) as new matter because of the new definition of the term "oriented nonwoven loop material." The examiner also rejected the claims under 35 U.S.C. 112, first paragraph, with the term "oriented nonwoven loop material" constituting new matter not sufficiently described in the specification. The remaining objections to the drawings and specification, also centered around the term "oriented nonwoven loop material." Therefore, these objections and rejections are all directly or indirectly related to new matter.

For the second requirement, the examiner objected to the specification and the drawings, and rejected the claims. Therefore, the second requirement, namely a rejection and an objection, has been satisfied.

Both requirements under MPEP 2163.06(II) have been satisfied so the issue is appropriately appealable. Accordingly, Points of Relief C, D, E, F and G, namely:

- Entry of Figures 8, 9a, and 9b;
- Withdrawal of the examiner's objection to the drawings under 37 CFR 1.83(a);
- Entry of the amendment to paragraph beginning "Figure 9 is" at page 5 of the specification;
- Withdrawal of the examiner's objection to the disclosure based on "oriented nonwoven loop material" being unclear and inconsistent;
- Withdrawal of the examiner's objection to the Amendment filed June 22, 2005 under 35 USC 132(a) as introducing new matter.

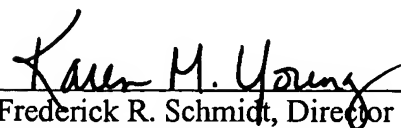
are dismissed.

Summary

The examiner is directed to enter corrections to Figures 2 and 3. However, the petitioner's other points of relief must be pursued through appeal rather than petition. Accordingly, Points of Relief A and B are GRANTED, and Points of Relief C, D, E, F and G are DISMISSED.

Petitioner may file a request for reconsideration of this decision, without fee. However, such a request must be filed within two months of the date of this decision. Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

PETITION GRANTED-IN-PART.


for Frederick R. Schmidt, Director
Technology Center 3700